

AUG 14 2007

Docket No.: 4590-418

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Denny WERNHAM *et al.*

U.S. Patent Application No. 10/539,623

Filed: June 17, 2005

For: AN OPTICAL FILTER

: Confirmation No. 2905

: Group Art Unit: Unassigned

: Examiner: Unassigned

RENEWED PETITION UNDER 37 C.F.R. §1.47(a)

Mail Stop PCT

Commissioner for Patents, Office of PCT Legal Administration

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

This is in response to the Decision dated June 14, 2007. In the Decision, it was stated that items (1), (3) and (4) were satisfied, but item (2) of 37 CFR §1.47(a) was not satisfied – by demonstrating: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/539,623 to the nonsigning inventor for his signature and (2) Mr. Wernham's refusal to sign, either in writing or by telephone. Applicants submit herewith a copy of the following documents:

- 1) Exhibit A - Letter dated 25 July 2007 from David Fleming, Legal & Compliance Director at Qioptiq Limited to Denny Wernham indicating that the specification, claims, drawings, abstract and declaration/power of attorney and assignment form for U.S. application 10/539,623 were enclosed.
- 2) Exhibit B - UPS shipping document with tracking number H705 443 128 7 dated 25 July 2007.
- 3) Exhibit C - UPS tracking detail which shows that the package was delivered to Denny Wernham on 26 July 2007.
- 4) Exhibit D - E-mail dated 26 July 2007 from Denny Wernham to David Fleming in which Denny Wernham states that his is unwilling to sign.

Application No.: 10/539,623**Docket No.: 4590-418**

In Exhibit D, Denny Wernham makes reference to the patent application entitled "an Optical Filter", which is the title of U.S. application 10/539,623.

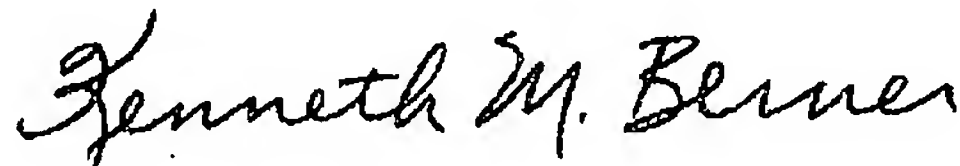
It is submitted that although Denny Wernham does not specifically refer to U.S. application 10/539,623, Denny Wernham did refer to the application by the correct title. Because proof has been submitted that the papers arrived the day before (July 26, 2007) Denny Wernham's e-mail of July 27, 2007, it is submitted that it is clear from the evidence that Denny Wernham refused to sign the declaration for U.S. application 10/539,623.

Based on the above, all outstanding requirements of 37 C.F.R. §1.47(a) having been satisfied, a favorable Decision on the above petition is hereby requested.

No additional petition fee is required. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

LOWE HAUPTMAN HAM & BERNER, LLP



Kenneth M. Berner
Registration No. 37,093

1700 Diagonal Road, Suite 300
Alexandria, Virginia 22314
(703) 684-1111
(703) 518-5499 Facsimile
Date: August 14, 2007
KMB/jlb

EXHIBIT A
LETTER JULY 25

Qloptiq Limited
Glascoed Road
St Asaph
Denbighshire
LL17 0LL
United Kingdom
Tel: +44 (0)1745 588000
Fax: +44 (0)1745 584258

European Space Research and Technology Centre
Keplerlaan 1 - Postbus 299
2200 AG Noordwijk
(The Netherlands)

Our ref: df

Date 25 July 2007

Email: david.fleming@uk.qloptiq.com

Dear Mr Wernham,

Enclosed are the application papers including-specification, claims, abstract and drawings as filed in the United States Patent and Trademark (USPTO) on June 17, 2005, filing number 10/539 623, title: An optical filter. Also attached are the copies of the Declaration and Assignment forms for your review and signature.

Please kindly sign the enclosed forms and forward to us as soon as possible.

If for any reasons you refuse to sign the attached documents, please let us know immediately by return fax or mail.

Best Regards

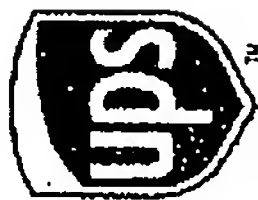
David Fleming
Legal & Compliance Director



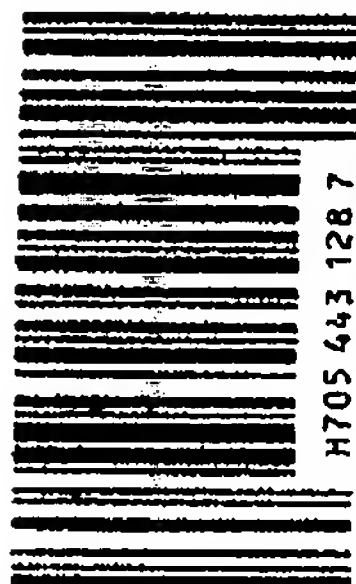
Registered Office Glascoed Road, St. Asaph, Denbighshire LL17 0LL
Registered in England & Wales Company Number 076004

EXHIBIT B SHIPPING DOCUMENT

SHIPPER'S COPY




WAYBILL
(Not Negotiable)



7815431287

<input type="checkbox"/> OPTIONAL SERVICES (see instruction) <input type="checkbox"/> UPS NAI <input type="checkbox"/> SATURDAY DELIVERY		SHIPPER'S SIGNATURE <i>[Signature]</i>	
SPECIAL INSTRUCTIONS (See back of box)		DATE OF SHIPMENT DD MM YY 25/10/10	

UPPS USE	DATE	FOR	COPIES	COPY
2. MATTHEW AS	25/10/7	14-45		<input type="checkbox"/>
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AUTHORITY HUSBAND CLARET JAMES				
MONEY RECEIVED				
AMOUNT				
NOTED				

4 SERVICE LEVEL	CLASS	10% USE
Express Plus	<input type="checkbox"/>	1+
Express	<input checked="" type="checkbox"/>	1
Express Saver	<input type="checkbox"/>	1P
Expedited	<input type="checkbox"/>	2
Standard IV	<input type="checkbox"/>	

<input type="checkbox"/> UPS Express Mail® Domestic Mail®	DROPPED VALUE FOR CARRIER - ADDITIONAL CHARGE APPLIES Special Rates Special Services		
1	RUBBER NO. 1 (ORIGINAL)	397	
	RUBBERNOSE NO. 2 (ORIGINAL)		
	SPECIAL DRIVE CODE		
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be used to specify which entries you are using. Missing currency information may lead to delay. In which US's values are not required.

**See Instructions
On Back**

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LIBRARY

SHIPPER'S UPS ACCOUNT NO. 1113 7777	SUPPLIER'S VAT No. 963147615000
NAME OF SENDER DAVID CLEMING	TELEPHONE No. (Very Important) 44-017455-880016
COMPANY NAME AND ADDRESS OPTIC LTD GLASCOW ROAD ST ASAPH	
DEMERIT CEMENTIRE POSTAL CODE (Very Important) 11701	RETURN'S VAT No. (Very Important) 0031715658445
RETURN'S UPS ACCOUNT No. 111701	RETURN'S VAT No. (Very Important) 0031715658445
CONTACT PERSON DENNY WERNER COMPANY NAME AND ADDRESS EUROPEAN SPACE RESEARCH AND TECHNOLOGY CENTRE KIEPLERLAND 1-POSTBUS 299 2200 AG NOORDWIJK COASTAL THE NETHERLANDS	RESIDENTIAL <input type="checkbox"/>
PAYMENT OF CHARGES (If not all options available to/from all countries) Bill Forwarding Charges For:	
<input checked="" type="checkbox"/> Special (S) <input type="checkbox"/> Credit Card (Charge only) SHIPPER'S ACCOUNT No. (This is Party 2's major credit card (dispute only))	<input type="checkbox"/> Receipts (R) TOWN PART (Country) Bank <input type="checkbox"/> Receipts (R) TOWN PART (Country) Bank
SHIPPER'S ACCOUNT No. (This is Party 2's major credit card (dispute only))	TOWN PART (Country) Bank

Revised 10/1/1994

12690764d01 Rev. 03/06 FN

UPS: Tracking Information

Page 1 of 1

EXHIBIT C
TRACKING DETAIL☒ Close Window

Tracking Detail

Your package has been delivered.

Tracking Number: H705 4431 287
Type: Package
Status: Delivered
Delivered On: 07/26/2007 9:53 A.M.
Signed By: HERMANS
Location: DOCK
Delivered To: ESTEC
1 KEPLERLAAN
NOORDWYK ZH, NL 2201
Shipped/Billed On: 07/25/2007
Reference Number(s): H7054431287
Service: EXPRESS
Weight: .50 Kg

Package Progress

Location	Date	Local Time	Description
ROTTERDAM, NL	07/26/2007	9:53 A.M.	DELIVERY
	07/26/2007	6:59 A.M.	OUT FOR DELIVERY
	07/26/2007	6:58 A.M.	IMPORT SCAN
	07/26/2007	6:40 A.M.	DESTINATION SCAN
	07/26/2007	6:15 A.M.	ARRIVAL SCAN
KOELN (COLOGNE), DE	07/26/2007	3:40 A.M.	DEPARTURE SCAN
	07/26/2007	12:48 A.M.	ARRIVAL SCAN
	07/26/2007	12:46 A.M.	ARRIVAL SCAN
EAST MIDLANDS AIRPOR, GB	07/25/2007	10:32 P.M.	DEPARTURE SCAN
GB	07/25/2007	12:49 P.M.	BILLING INFORMATION RECEIVED

Tracking results provided by UPS: 07/30/2007 6:43 A.M. ET

NOTICE: UPS authorizes you to use UPS tracking systems solely to track shipments tendered by or for you to UPS for delivery and for no other purpose. Any other use of UPS tracking systems and information is strictly prohibited.

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https://wwwapps.ups.com/WebTracking/printSummary?loc=en_US&page=print&ro... 30/07/2007

UPS: Tracking Information

Page 1 of 1



[Close Window](#)

Tracking Summary

Tracking Numbers

Tracking Number:	H705 4431 287
Type:	Package
Status:	Delivered
Delivered On:	07/26/2007 9:53 A.M.
Delivered To:	NOORDWYK ZH, NL
Signed By:	HERMANS
Service:	EXPRESS

Tracking results provided by UPS: 07/26/2007 5:07 A.M. ET

NOTICE: UPS authorizes you to use UPS tracking systems solely to track shipments tendered by or for you to UPS for delivery and for no other purpose. Any other use of UPS tracking systems and information is strictly prohibited.

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https://wwwapps.ups.com/WebTracking/printSummary?loc=en_US&page=summary... 26/07/2007

FW: URGENTLY - Our Ref 62988 - AN OPTICAL FILTER

EXHIBIT D
E-MAIL JULY 26

Sujet: FW: URGENTLY - Our Ref 62988 - AN OPTICAL FILTER

De: "Guilliatt, Julie" <Julie.Guilliatt@uk.qioptiq.com>

Date: Thu, 26 Jul 2007 16:20:35 +0100

Pour: "danielle.thivel@fr.marks-clerk.com" <danielle.thivel@fr.marks-clerk.com>

Copie: "Fleming, David" <David.Fleming@uk.qioptiq.com>

Dear Danielle Thivel,

In response to your email below we sent the US Application with covering letter by certified mail to Denny Wernham, the non-signing inventor.

The letter was sent yesterday with the attachments to this email. The attachments were:

62988 Amended Sheet,
62988 English Specification,
62988 Drawings,
62988 Power of Attorney,
62988 Cessation,
62988 Declaration for Patent Application,
62988 Power 2

We received delivery confirmation this morning and a response from Denny Wernham this afternoon.

Please let me know whether this is sufficient for the US Patent Office.

I attach a copy of the covering letter, the certified mail receipt and Mr Denny Wernham's reply.

Kind Regards
Julie Guilliatt

Legal Assistant
Qioptiq Limited

-----Original Message-----

From: Danielle THIVEL [mailto:danielle.thivel@fr.marks-clerk.com]

Sent: 17 July 2007 08:38

To: David FLEMING

Cc: HENRIOT Marie-Pierre; ESSELIN Sophie

Subject: URGENTLY - Our Ref 62988 - AN OPTICAL FILTER

Importance: High

URGENTLY

US Patent application N° 10/539 623

Our Ref 62988

"AN OPTICAL FILTER"

Inventors : D. WERNHAM, J. RUSSEL, G.M. JONES

FW: URGENTLY - Our Ref 62988 - AN OPTICAL FILTER

This email and any attachments are confidential to the intended recipient and may also be privileged. If you are r

Qioptiq Ltd
Registered Office Glascoed Road, St. Asaph, Denbighshire LL17 0LL
Registered in England & Wales Company Number 876004

Sujet: FW: Assignment of Application "An optical filter"
De: "Fleming, David" <David.Fleming@uk.qioptiq.com>
Date: Thu, 26 Jul 2007 15:22:17 +0100
Pour: "Guilliatt, Julie" <Julie.Guilliatt@uk.qioptiq.com>

-----Original Message-----

From: Denny.Wernham@esa.int [mailto:Denny.Wernham@esa.int]
Sent: 26 July 2007 15:03
To: david.fleming@uk.qioptiq.com
Subject: Assignment of Application "An optical filter"

Dear David,

with reference to patent application "An optical filter", my position remains unchanged from our previous communications on this matter.

In order that I can ascertain an estimation of the value of this transferral, I request the total volume and sales figures for all components sold that are relevant to this patent.

As per my previous communications and advice that I have received on the matter, the sum of \$5 does not represent a fair reflection on the sales and profits that have been made on products which are reliant upon the inventions contained within the patent.

I therefore suggest that you revise this accordingly for all 3 named inventors.

On the issue regarding the follow-up support of this patent, as I am no longer part of your organisation, this would have to be subject to reasonable terms and conditions and subject to any restrictions placed upon me as an employee of the European Space Agency.

Note that this is not a refusal to sign the document under any circumstances. I am however, unwilling to sign the document in its current state for the reasons cited above.

Regards,

Dr. Denny Wernham
The European Space Agency

Letter to Wernham 25.07.07.doc

Content-Type: application/msword
Content-Encoding: base64

FW: URGENTLY - Our Ref 62988 - AN OPTICAL FILTER

Tracking doc.PDF	Content-Type: application/octet-stream
	Content-Encoding: base64

FW: Assignment of Application "An optical filter".eml	FW:
	Assignment of
	Content-Description: Application "An optical filter"
	Content-Type: message/rfc822